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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-------------------------|-------------|----------------------|---------------------|------------------|
| 09/935,393 | 08/23/2001 | William Kress Bodin | AUS920010655US1 | 9825 |
| 45993 | 7590 | 10/31/2006 | EXAMINER | |
| IBM CORPORATION (RHF) | | | SMITH, TRACI L | |
| C/O ROBERT H. FRANTZ | | | ART UNIT | PAPER NUMBER |
| P. O. BOX 23324 | | | | 3629 |
| OKLAHOMA CITY, OK 73123 | | | | |

DATE MAILED: 10/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | |
|------------------------------|----------------------------|----------------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 09/935,393 | BODIN, WILLIAM KRESS |
| | Examiner Traci L. Smith | Art Unit 3629 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 28 July 2006.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-30 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

| | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ . |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ . | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION

This action is in response to papers filed on July 28, 2006.

No claims have been amended.

Claims 1-30 are pending.

Claims 1-30 are rejected.

1. In view of the appeal brief filed on July 28, 2006, PROSECUTION IS HEREBY REOPENED. A new grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

Claim Rejections - 35 USC § 102

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-5, 10-15, 20-25 and 30 are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent Publication 20010028301 Geiger et al. Electronic Shopping Cart Display System. Hereinafter referred to as Geiger.

3. As to claims 1, 11 and 21 Geiger teaches:

Identifying a consumer(Pg. 6 ¶ 73).

Retrieving preferences of consumer(Pg. 6 ¶7 Pg 8 105).

Matching products with preferences(Pg. 1 ¶ 9; Pg. 4 ¶ 47-48).

Indicator of matching product(Pg. 1 ¶9).

4. As to claims 2, 12 and 22 Geiger teaches the identifying with a magnetic strip card.(Pg. 6 ¶ 73).

5. As to claims 3, 13 and 23 Geiger teaches accessing a database.(Pg 8 ¶95)

6. As to claims 4, 14 and 24 Geiger teaches matching price(Pg. 5 ¶58).

7. As to claims 5, 15 and 25 Geiger teaches indicator as light, text etc(Pg. 1 ¶ 9).

8. As to claims 10, 20 and 20 Geiger teaches the database maintaining inventory information.(Pg. 4 ¶ 48 & Pg. 8 ¶ 99).

Claim Rejections - 35 USC § 103

9. Claims 6-9, 16-19 and 26-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over. US Patent Publication 20010028301 Geiger et al. Electronic Shopping Cart Display System. Hereinafter referred to as Geiger.

10. As to claims 6-9, 16-19 and 26-29 Geiger teaches an intelligent merchandise indicator in which the system is further used as an advertising/promotion system for direct marketing to consumers. However, Geiger fails to teach sending product reference information to consumer via email message. It would have been obvious to combine Geiger's direct marketing system with an email system for emailing the information to the consumers as online advertising is a commonly used form of direct marketing campaigns.

Response to Arguments

11. Applicant's arguments with respect to claims 1-30 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Traci L. Smith whose telephone number is 571-272-6809. The examiner can normally be reached on Monday-Thursday 6:00 am-4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 571-272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

TLS



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